

Claims 1, 3 to 9 and 11 to 14 have been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The Supervisory Patent Examiner alleges (1) that the claim(s) contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention and (2) that there is no disclosure for both the pin 48 and the catch being movable or the catch being movable. Reconsideration of this rejection is requested.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116.

Original claim 1 of the application claimed a tilt mechanism for an umbrella comprising, inter alia, "a first tubular member. . . ; a second tubular member. . . ; a catch mounted in one of said members. . . having a plurality of recesses at an end. . and a pin mounted in said other of said tubular members transversely of and in one of said recesses of said catch. . ." Dependent claim 2 further characterized the tilt mechanism in that "at least one of said pin and said catch are movable relative to each other to release said pin from a selective one of said recesses". It is patently clear that the applicant was in possession of the invention as recited in claims 1 and 2 wherein at least one of the catch and pin were movable relative to the other since this is stated in *haec verba*.

There is no question that original claim 2 (and present claim 1) is readable on the structure illustrated in the drawings and described in the specification, i.e. that there is a catch 40 (see Fig. 3) mounted in one tubular member 33 and that there is a pin 48 mounted in the other tubular member 34. Also, there is no question that at least one of the pin 48 and the catch 42 is movable coaxially relative to the other in order to release the pin 48 from the catch 42. As illustrated, the pin 48 is movable while catch 40 is fixed.

Simply stated, claim 1 is generic to (1) a structure as illustrated in Fig. 3 wherein the catch 40 is fixed and the pin 48 is movable, (2) a structure wherein the catch 40 is movable within the tubular element 33 and the pin 48 is fixed in the tubular member 34 (such is merely a reversal of parts well within the skill of the art) and (3) a structure wherein each of the catch 40 and pin 48 are movable.

Original claim 2 which has been incorporated into claim 1 clearly teaches one skilled in the art that the inventor had possession of the claimed invention, namely that (1) the catch 40 may be fixed and the pin 48 movable; or (2) that the catch 40 may be movable and the pin 48 fixed; or (3) that both of the catch 40 and the pin 48 may be movable within the scope of the invention intended and claimed by the inventor.

Clearly, the applicant had possession of the claimed invention since the invention was expressed in the terms set forth in original claim 2.

There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) ("we are of the opinion that the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not

recognize in the disclosure a description of the invention defined by the claims"). Neither the Examiner nor the Supervisory Patent Examiner has carried this burden.

During the interview, the undersigned attorney stated an intent to have the Supervisory Patent Examiner provide her Affidavit pursuant to the provisions of 37 CFR 1.104 (d)(2) to support the rejection of the claims. However, the Supervisory Patent Examiner stated an intent not to provide such an Affidavit.

It is respectfully requested that the Supervisory Patent Examiner provide an Affidavit pursuant to 37 CFR 1.104 (d)(2) to support the allegation in the rejection of the claims that the rejected claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention being claimed.

The Examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims.¹ There is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed, *Wertheim*, 541 F.2d at 262, 191 USPQ at 96.... **Consequently, rejection of an original claim for lack of written description should be rare.** The inquiry into whether the description requirement is met is a question of fact that must be determined on a case-by-case basis. See *In re Smith*, 458 F.2d 1389, 1395, 173 USPQ 679, 683 (CCPA 1972) ("Precisely how close [to the claimed invention] the description must come to comply with Sec. 112 must be left to case-by-case development."); *In re Wertheim*, 541 F.2d at 262, 191 USPQ at 96

¹ The rejection of the claims in question was first presented on October 5, 2004. Five prior Office Actions did not raise a rejection under 35 U.S.C. 112.

(inquiry is primarily factual and depends on the nature of the invention and the amount of knowledge imparted to those skilled in the art by the disclosure).

The absence of definitions or details for well-established terms or procedures should not be the basis of a rejection under 35 U.S.C. 112, para. 1, for lack of adequate written description. (MPEP 2163, II, A,1)

A specification may describe an actual reduction to practice by showing that the inventor constructed an embodiment or performed a process that met all the limitations of the claim and determined that the invention would work for its intended purpose. *Cooper v. Goldfarb*, 154 F.3d 1321, 1327, 47 USPQ2d 1896, 1901 (Fed. Cir. 1998).

If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. See, e.g., *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116; *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972) (stating "the description need not be in *ipsis verbis* [i.e., "in the same words"] to be sufficient").

A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97. In rejecting a claim, the examiner must set forth

express findings of fact regarding the above analysis which support the lack of written description conclusion. These findings should:

(A) Identify the claim limitation at issue; and

(B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. A general allegation of "unpredictability in the art" is not a sufficient reason to support a rejection for lack of adequate written description.

For the above reasons, a rejection of claims 1, 3 to 9 and 11 to 14 under 35 USC 112, first paragraph is not warranted.

Further, during the interview, the undersigned attorney specifically noted that independent claim 5 is specifically directed to the embodiment illustrated, for example in Figs. 2 and 3 wherein the pin 48 is movable noting that claim 5 requires "a catch mounted in one of said members. . . and a pin slidably mounted in the other of said tubular members. . . said pin being movable coaxially away from said catch. . . ". The undersigned attorney requested Supervisory Patent Examiner Mai to reconsider the rejection of claim 5. However, Supervisory Patent Examiner Mai adhered to the rejection of claim 5 as not being supported by the specification. This is particularly perplexing and applicant requests clarification of rejection of claim 5 for purposes of Appeal and the record.

Claim 13 which depends from claim 9 specifically requires the pin to be slidably mounted to move away from the catch. Accordingly, for reasons as expressed above with respect to claim 5, clarification of the rejection of claim 13 is requested for purposes of Appeal and the record.

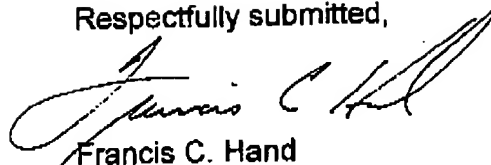
The application is believed to be in obvious condition for allowance and such is respectfully requested.

Note is made of the Examiner's response in the paragraph bridging pages 2 and 3 of the Final Rejection. The Examiner alleges that applicant has not demonstrated in the specification that applicant had possession of the invention to the "catch being movable". As previously noted, the best mode of the invention has been described and claimed in the original application, i.e. an embodiment wherein the catch is fixed and the pin is movable. Further, original claim 2 clearly discloses that "at least one of said pin and said catch are movable relative to each other to release said pin from a selective one of said recesses". Thus, original claim 2 clearly provided a disclosure that the inventor was in possession of an embodiment wherein the catch is movable and the pin is fixed or an embodiment wherein both the catch and the pin are movable. Still further, constructing a tilt mechanism wherein the pin 48 is fixed and the catch 40 is movable does not require "undue experimentation" as alleged by the Examiner. To the extent that the Examiner believes that this would require "undue experimentation", the Examiner is invited to and requested to provide an Affidavit to that effect pursuant to the provisions of 37 CFR 1.104 (supra).

Note is made that the rejected claims were previously allowed and a Notice of Allowance issued on August 2, 2004. Subsequently, the application was withdrawn from issue pursuant to an office communication dated August 17, 2004 over the signature of John J. Love, Director. Accordingly, it is requested that this application be re-submitted to John J. Love, Director for review.

The application is believed to be in obvious condition for allowance and such is respectfully requested.

Respectfully submitted,



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